Remarks:

The following remarks are responsive to the Office action dated July 18, 2005.

Claims 1-30 are pending in the application. In the Office action, the Examiner rejected

claims 1-30 as being anticipated under 35 U.S.C. § 102(b) or obvious under 35 U.S.C.

§ 103(a). Applicant traverses these rejections, contending that the rejected claims are

neither anticipated nor obvious.

Nevertheless, to expedite the issuance of a patent, and to more particularly

point out and distinctly claim aspects of the invention that applicant would like to

patent now, applicant has amended claim 30. Applicant reserves the right to pursue

claim 30 in original form at a later time. Furthermore, applicant has presented

arguments showing that claims 1-30 are neither taught nor suggested by any of the

references of record. Accordingly, in view of the foregoing amendments and the

following remarks, applicant respectfully requests reconsideration of the application

under 37 C.F.R. § 1.111 and allowance of the pending claims.

A.   *Claim Rejections – 35 U.S.C. § 102*

The Examiner rejected claims 1-10, 12-20, and 22-29 under 35 U.S.C.

§ 102(b) as being anticipated by U.S. Patent No. 5,680,455 to Linsker et al.

("Linsker"). Applicant traverses the rejections. Linsker does not teach or suggest

every element of the rejected claims for the reasons set forth below.

Claim 1

Claim 1 is directed to a method:

> 1.   (Previously Presented) A method for regulating the ability of a
> sender to print on a printer, comprising the steps of:
> receiving, at a printer, a print job from a sender, where the print job
> includes a representation of a document and an aspect of the print job that is
> encrypted with a private key of the sender;
> verifying the sender by decoding the aspect using a public key of the
> sender, where the public key and the private key form a key pair; and

Page 7 -   AMENDMENT
              Serial No. 09/905,415
              HP Docket No. 10010635-1
              KH Docket No. HPCB 326

printing the document on the printer only if the aspect of the print job
is decoded successfully.

Linsker does not teach or suggest every element of claim 1. For example, Linsker

does not teach or suggest "printing the document on the printer only if the aspect of

the print job is decoded successfully."

In the Office action, the Examiner asserted that Linsker teaches printing only if

the aspect of the print job is decoded successfully. In particular, the Examiner cited

col. 4, line 66, through col. 5, line 50, of Linsker in support of this assertion.

Applicants strongly disagree. Neither the cited section of Linsker nor Linsker as a

whole teaches or suggests printing only if the aspect of the print job is decoded

successfully, as recited by claim 1.

Only the last paragraph (col. 5, lines 41-50) of the cited section of Linsker

relates directly to printing. This paragraph states:

> The result of processing by the image digest comparator 207 is the
> determination that the sender is authentic (i.e., used the private key that is
> indeed the inverse of the purported sender's public key) or not. This result is
> preferably formatted into human-readable form and sent to the two-line
> memory 12 via the switch 209, so that it will be printed along with the DS-
> GVR page. Alternatively, this result may be signaled to the recipient by other
> means (e.g., an audible signal, a message on the receiving facsimile
> machine's display, or the like). (emphasis added by applicant)

The processing disclosed by Linsker thus involves a determination of whether or not

the sender is authentic through the use of encryption and decoding using public and

private keys. This "result" (the determination of whether or not the sender is

authentic) is formatted and then printed. Accordingly, Linsker discloses printing that

is performed whether or not the sender is authentic and thus whether or not

decoding is successful. In particular, Linsker discloses printing if the sender is

authentic (decoding is successful because the private key is the inverse of the

purported sender's public key) and printing if the sender is not authentic (decoding is

Page 8 -   AMENDMENT
              Serial No. 09/905,415
              HP Docket No. 10010635-1
              KH Docket No. HPCB 326

not successful because the private key is not the inverse of the purported sender's public key). Linsker thus does not teach or suggest "printing the document on the printer only if the aspect of the print job is decoded successfully."

Linsker does not teach or suggest every element of claim 1. Claim 1 thus should be allowed. Claims 2-11, which depend from claim 1, also should be allowed for at least the same reasons as claim 1.

Claim 12

Claim 12 is directed to a system:

> 12. (Previously Presented) A system for regulating the ability of a sender to print on a printer, comprising:
> a sending processor that includes a private key of a sender, where the private key forms a key pair with a public key, the sending processor being adapted to encrypt an aspect of a print job using the private key and to send the print job and encrypted aspect over a network; and
> a printer in communication with the sending processor, where the printer is adapted to receive the print job and encrypted aspect from the sending processor, to verify the sender by decoding the encrypted aspect using the public key, and to print a document based on the print job only if the aspect of the print job is decoded successfully.

Linsker does not teach or suggest every element of claim 12. For example, according to the analysis of Linsker presented above in relation to claim 1, Linsker does not teach or suggest a printer adapted "to print a document based on the print job only if the aspect of the print job is decoded successfully." Claim 12 thus should be allowed. Claims 13-21, which depend from claim 12, also should be allowed for at least the same reasons as claim 12.

Claim 22

Claim 22 is directed to a printer:

> 22.   (Previously Presented) A printer capable of regulating output of a print job from a sender, comprising:
> a printer in communication with a sender and adapted to receive a print job that has an aspect encrypted with a private key of the sender, to verify the sender by decoding the aspect using a public key of the sender that forms a key pair with the private key, to determine if the sender with the private key has permission to print, and to output the print job only if the aspect of the print job is decoded successfully.

Linsker does not teach or suggest every element of claim 22. For example, according to the analysis of Linsker presented above in relation to claim 1, Linsker does not teach or suggest a printer adapted "to output the print job only if the aspect of the print job is decoded successfully." Claim 22 thus should be allowed. Claims 23-29, which depend from claim 22, also should be allowed for at least the same reasons as claim 22.

B.   Claim Rejections – 35 U.S.C. § 103

The Examiner rejected claims 11, 21, and 30 under 35 U.S.C. § 103(a) as being obvious over Linsker in view of U.S. Patent No. 6,185,684 to Pravetz et al. ("Pravetz"). Applicant traverses the rejections. Neither Linsker nor Pravetz, taken alone or in combination, teaches or suggests every element of the rejected claims. Nevertheless applicant has amended claim 30.

Claims 11 and 21

In the Office action, the rejection of dependent claims 11 and 21 as being obvious was based on the Examiner's assertion of anticipation of independent (parent) claims 1 and 12, respectively, by Linsker. Applicant demonstrated in the preceding section that claims 1 and 12 are not anticipated by Linsker. Therefore, for at least this reason, claims 11 and 21 are not obvious and should be allowed.

Page 10 -   AMENDMENT
              Serial No. 09/905,415
              HP Docket No. 10010635-1
              KH Docket No. HPCB 326

Claim 30

Claim 30 is directed to a method:

>   30.   (Currently Amended) A method for regulating the ability of a user to print on a printer, comprising the steps of:
>   receiving, at a printer, a print job from a user, where the print job includes a representation of a document and an aspect of the print job that is encrypted with a private key of the user;
>   verifying the user by decoding the aspect using a public key of the user, where the public key and the private key form a key pair;
>   determining, in a process distinct from verifying, if the user with the private key has permission to print; and
>   printing the document on the printer only if the **aspect is decoded successfully and the** user is-a-verified-user-and has permission to print.

Neither Linsker nor Pravetz, taken alone or in combination, teaches or suggests every element of claim 30. For example, according to the analysis of Linsker presented above in relation to claim 1, Linsker does not teach or suggest printing "only if the aspect is decoded successfully." Pravetz also does not teach or suggest printing only if the aspect is decoded successfully (using a public key of the user). Claim 30 thus should be allowed.

/////

/////

/////

/////

/////

/////

/////

/////

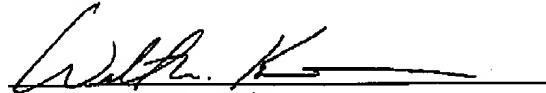/////

/////

Page 11 -   AMENDMENT
             Serial No. 09/905,415
             HP Docket No. 10010635-1
             KH Docket No. HPCB 326

C.   _Summary_

Applicant believes that this application is in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

Walter W. Karnstein
Registration No. 35,565
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicant

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner B. Hoffman, Group Art Unit 2136, Assistant Commissioner for Patents, at facsimile number (703) 872-9306 on October 17, 2005.

Christie A. Doolittle

Page 12 -   AMENDMENT
Serial No. 09/905,415
HP Docket No. 10010635-1
KH Docket No. HPCB 326